

U.S. Patent 6,353,038
DECLARATION OF JIMMY LUCCHESI

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent 6,353,038

Allan AHO et al.

Serial Number: 09/446,630

Issued: March 5, 2002

For: NOVEL PLASTIC BASED COMPOSITE AND ITS USE

DECLARATION OF JIMMY LUCCHESI

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Jimmy LUCCHESI, hereby declare as follows:

Scientific Training and Employment History

1. I earned my undergraduate degree in biotechnology engineering from the Espoo-Vantaa Institute of Technology, Vantaa, Finland, in 1997.
2. From 1999 to 2005 I pursued a master's degree in biosciences at the University of Helsinki, Finland.
3. From January 1, 1995 to March 31, 2002 I was employed as a research scientist in the research groups of Prof. Mart Saarma and Docent Kristiina Mäkinen, seeking to elucidate the functions of specific plant virus proteins.

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4. From March 1, 2002 to August 28, 2005 I was employed as a Laboratory Engineer/Research Scientist by Unicrop Ltd., a plant biotech research and development company located in Helsinki, Finland.

5. From November 1, 2006 to December 16, 2009 I was employed by Vivoxid Ltd., a research and development company located in Turku, Finland focused on bioactive and bioresorbable silica- and titanium oxides ("Vivoxid"). My initial position was market analyst. I was promoted to Market Development Manager, effective December 3, 2008.

6. On information and belief, Vivoxid has always had less than 30 employees and none dedicated to only patent matters. In addition to my other responsibilities, I had sole responsibility for Vivoxid's intellectual property matters, including timely payment of maintenance fees for U.S. patents and annuity fees for non-U.S. patent applications and patents.

7. In late 2009 Vivoxid split into two companies: Vivoxid and BonAlive Biomaterials Ltd., a manufacturer and distributor of biomaterials located in Turku, Finland ("BonAlive"). I have been employed by BonAlive since the split, December 17, 2009, to the present. My initial position was Market Development Manager. I was promoted to R&D Manager effective June 1, 2010.

8. My curriculum vitae is attached.

Vivoxid's Maintenance Fee Payment System

9. In 2009, Vivoxid's patent portfolio comprised more than 15 patent families, with some families having more than 20 pending applications and issued patents. Vivoxid

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employed a shorthand name for each patent family for convenience. Thus, "Sulamuovi" is an internal Vivoxid shorthand for a patent family which includes U.S. Patent 6,353,038 ("the '038 patent"). Other Vivoxid shorthand names for its patent families include "Ti-geeli", "Lonkkaprotpinnoitus" and "Iskuluja biohajoava materiaali".

10. Vivoxid did not maintain an internal docket for maintenance and annuity payments. Instead, Vivoxid contracted with Patrafee Oy AB, a commercial annuity payment service company, to handle its annuity and maintenance fee payments. Mr. Peter Holmqvist was the Patrafee employee I dealt with in connection with the docketing and payment of Vivoxid's annuity and maintenance fee payments.

11. I would inform Patrafee of each new Vivoxid application or patent for which an annuity or maintenance fee would be payable. Patrafee would enter the relevant information into its docketing system, and would periodically send me a reminder listing those annuities and maintenance fees which would become due in the next few months. Each of these fees would be paid unless I instructed Patrafee not to pay a specific annuity or maintenance fee.

12. Patrafee would invoice Vivoxid for annuity and maintenance fee payments before they were actually paid. Accordingly, the word "payment" was sometimes used synonymously with "patent" or "patent application" in my correspondence with Mr. Holmqvist.

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Facts Surrounding Non-Payment of the Second Maintenance Fee

13. Exhibit 1 is a Patrafee reminder dated March 5, 2009 to Vivoxid which correctly lists the '038 patent, its maintenance fee due date of 5 September 2009, and Vivoxid's patent family reference "Sulamuovi".

14. On March 12, 2009 I informed Mr. Holmqvist that Vivoxid wished to permit its "Ti-geeli" and "Lonkkaproteesipinnolitus"¹ patent families to lapse. See Exhibit 2. My question concerning "how to handle this" related to Patrafee's invoice dated March 19, 2009 which included the maintenance fees for the "Ti-geeli" and "Lonkkaproteesipinnoitus" patent families which were not to be paid.

15. Mr. Holmqvist replied by an e-mail dated June 5, 2009 (Exhibit 3) which acknowledged my instructions regarding the non-payment of annuities for the "Ti-geeli" and "Lonkkaprotpinnoitus" patent families ("These are August cases"). However, his e-mail also mistakenly lists the '038 patent with the wrong Vivoxid patent family reference:

"In September only one: US 6353038 Lonkkaprotpinnoitus"

16. I did not realize Mr. Holmqvist's mistake. Instead, I assumed the '038 patent belonged to the Lonkkaprotpinnoitus patent family, which Vivoxid had decided to abandon. I accordingly confirmed the '038 patent should be abandoned in an e-mail sent him on June 5, 2009 (Exhibit 4). The statement in my e-mail "the payment should

¹"Lonkkaproteesipinnoitus" is a Finnish compound noun meaning "hip prosthesis coating". The more commonly-used version "Lonkkaprotpinnoitus" is a slightly abbreviated form of the compound noun.

be cancelled at once" reflects my concern that Patrafee not invoice us for this maintenance fee because the patent family was to be abandoned.

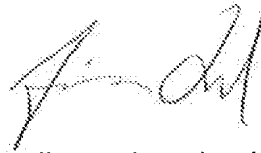
17. I do not know why I did not recognize and correct Mr. Holmqvist's original mistake. However, I did have a significantly heavier workload at the time this mistake occurred. The employment contracts of two members of Vivoxid's executive group were suddenly and surprisingly terminated at the end of 2008. One of the terminated executives was my superior. The terminations led to a major reorganization of responsibilities among the remaining Vivoxid employees, which resulted in a temporary but significant increase in my duties.

18. On information and belief, Mr. Holmqvist sent me a letter dated June 9, 2009 stating that the '038 patent was to be permitted to lapse. See Exhibit 6, which contains the correct patent number and correct patent family reference "Sulamuovi" for the '038 patent.

19. On information and belief, Vivoxid either did not receive Exhibit 6 or misplaced it. I make this statement after determining that Exhibit 6 is not in Vivoxid's files for the "Sulamuovi" patent family. Exhibit 6 is also not in Vivoxid's files for its "Lonkkaprotpinnoitus" patent family.

20. All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. These statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the '038 patent.

Signed this 17th day of April, 2012.

A handwritten signature in black ink, appearing to read "Jimmy Lucchesi", written in a cursive style.

Jimmy Lucchesi

CURRICULUM VITAE

PERSONAL INFORMATION

Name
Telephone
E-mail

LUCCHESI JIMMY
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WORK EXPERIENCE

- Dates (from to) 01.06.2010 –
• Name and address of employer BonAlive Biomaterials Ltd, Biolinja 12, 20750 Turku
• Type of business or sector Manufacturer and distributor, S&M, biomaterials
• Occupation or position held R&D Manager
- Dates (from to) 17.12.2009 – 31.5.2010
• Name and address of employer BonAlive Biomaterials Ltd, Biolinja 12, 20750 Turku
• Type of business or sector Manufacturer and distributor, S&M, biomaterials
• Occupation or position held Market Development Manager
• Main activities and responsibilities Overall management of R&D
- Dates (from to) 03.12.2008 – 16.12.2009
• Name and address of employer Vivoxid Ltd, Biolinja 12, 20750 Turku
• Type of business or sector R&D and sales company, biomaterials
• Occupation or position held Market Development Manager
• Main activities and responsibilities Mapping of current and novel indications for use, product segmentation analysis
- Dates (from to) 01.11.2006 – 02.12.2008
• Name and address of employer Vivoxid Ltd, Tykistökatu 4 A, 20520 Turku
• Type of business or sector R&D and sales company, biomaterials
• Occupation or position held Market Analyst
• Main activities and responsibilities To support the deal structuring of b2b partnership in the Business Development department
- Dates (from to) 01.04.2002 – 28.08.2005
• Name and address of employer Unicrop Ltd, Viikinkaari 4, 00790 Helsinki
• Type of business or sector R&D company, plant biotech
• Occupation or position held Laboratory Engineer / Research Scientist
• Main activities and responsibilities [I] To manage a small research team with the aim to optimise transgenic protein production yields [II] To design and order novel sprouting vessels [III] To develop and optimise transformation methods and [IV] To manage and maintain the servers (Linux) and PCs (Win XP) of the company
- Dates (from to) 1998 - 2001
• Name and address of employer Espoo-Vantaa Institute of Technology, Leiritie 1, 01600 Vantaa
• Type of business or sector Education
• Occupation or position held Part-time Teacher
• Main activities and responsibilities Organiser of a lab course "Uuden biotekniikan laboratoriotyöt", 40 hours/term

- Dates (from to) 01.01.1995 – 31.03.2002
 - Name and address of employer Institute of Biotechnology, Viikinkaari 9, 00014 University of Helsinki
 - Type of business or sector Academic research
 - Occupation or position held Research Scientist in the groups of prof. Mart Saarma and docent Kristiina Mäkinen
 - Main activities and responsibilities To elucidate the functions of specific plant virus proteins using methods of molecular biology
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- Dates (from to) 01.06.1993 – 31.08.1994
 - Name and address of employer Institute of Biotechnology, Viikinkaari 9, 00014 University of Helsinki
 - Type of business or sector Academic research
 - Occupation or position held Research Assistant in the group of prof. Mart Saarma
 - Main activities and responsibilities The aim was to produce virus resistant transgenic plants

EDUCATION AND TRAINING

- Dates (from to) 16.11.2011 – 18.11.2011
 - Name of organisation providing education and training Key2Compliance, Lundén/Ellow ab and EuroGMP AB Tjädervägen 10, SE-181 56 Lidingö, Sweden
 - Title of qualification awarded Design control requirements and industry practice
-
- Dates (from to) 16.06.2006 – 04.01.2007
 - Name of organisation providing education and training TalentGate, Porkkalankatu 20, 00180 Helsinki
 - Title of qualification awarded ProjectTalent
-
- Dates (from to) 29.03.2006 – 31.06.2006
 - Name of organisation providing education and training Top-Resurssi Oy, Pohjoisranta 11, 28100 Pori
 - Title of qualification awarded From idea to entrepreneurship
-
- Dates (from to) 10.01.2005 – 15.06.2005
 - Name of organisation providing education and training Turun ammattikorkeakoulu, täydennyskoulutuskeskus, Kaskenkatu 5, 20700 Turku
 - Title of qualification awarded International marketing of bioscience products
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- Dates (from to) 1999 – 2005
 - Name of organisation providing education and training University of Helsinki, Faculty of biosciences, Viikinkaari 5, 00014 HY
 - Title of qualification awarded Master of biosciences, studies uncompleted
-
- Dates (from to) 18.08.1992 – 25.05.1997
 - Name of organisation providing education and training Espoo-Vantaa Institute of Technology, Leiritie 1, 01600 Vantaa
 - Title of qualification awarded Engineer in biotechnology